

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of

Ronald D. HOUSE et al.

Group Art Unit: 2625

Application No.: 10/630,863

Examiner: N. MCLEAN

Filed: July 31, 2003

Docket No.: 112226

For: MULTI-FUNCTION IMAGE FORMING DEVICE WITH BUILT-IN READ/WRITE
CD UNIT

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The following remarks are directed to arguments raised in the Examiner's Answer dated December 23, 2008.

Claims 5-6, 8-10, 12 and 15 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0105665 to Wasilewski et al. (hereinafter "Wasilewski"), in view of U.S. Patent No. 5,988,431 to Roe. In responding to the arguments presented in Appellants' Brief on Appeal, the Examiner's Answer, on pages 10-13, continues to misinterpret the disclosures of Wasilewski and Roe.

I. Wasilewski Requires That A User Make All Decisions Regarding The Transaction As Prompted

The Examiner's Answer asserts that the act of purchasing requires a user to select goods or services, and in the particular case for initiating the process. This assertion is incorrect.

Wasilewski is directed to a method of integrating photographic imaging products and services functionality with non-imaging functionality using the automatic teller machine (ATM) functions for providing financial transactions at a single kiosk (Abstract). Wasilewski teaches, at paragraph [0056], lines 17-20, that through the user interface 11 and application software that resides in the computer 16, the consumer/customer selects an imaging product or service, and is then instructed to perform the appropriate set of operations. Further, Wasilewski teaches that, at paragraph [0060], lines 4-23, when a customer desires to request an image product and/or service 200, the customer initiates a request on kiosk 100 and follows the prompts on the touch screen user interface 102. The customer selects the image source 202 of an image. For example, the user is questioned whether to obtain an image from a remote location via the network connection 118, imaging camera 101, image scanner 106, or from a file stored on media such as a CD, memory card/stick, disk using the peripheral options available on the computer 112, so as to begin the image acquisition process 204. Once the image is acquired, the customer can perform any image edits or enhancements allowed by kiosk 100 to get the desired image 206 for the image product/service. The customer is also prompted to select the particular image product/service 208. Prior to rendering the image product/service, the customer is prompted to select desired payment method, for example, debit card, credit card, smart card, payment via ATM functionality using either the multi-card reader 116 or ATM process 214; 216, via communication device 117 over the network connection 118.

While the pending claims may require a user to initiate the transaction and/or make a payment, none of the steps recited in the pending claims require a user to make any required decision as prompted, or at all. Wasilewski, as indicated above, teaches that a user must make decisions throughout the entire transaction via the touch screen or other interface. It is for at least this reason, that Wasilewski would not have suggested at least purchase determining whether to purchase blank media, media transfer determining whether to transfer image data between physical media, network transfer determining whether to transfer the image data from network, upload transfer determining whether to upload the image data to a network upload, transferring a computer image file from a network storage, dispensing the portable digital storage media, and selecting a remote target as recited in the pending claims.

II. Wasilewski And Roe are Not Combinable in the Manner Suggested by the Office Action Because the Combination of Applied References Would Impermissibly Modify the Principle of Operation of the Primary Reference

The Examiner's Answer asserts that Wasilewski is mainly directed to an integrated kiosk that provides imaging products and services and that an aspect of Wasilewski is the inclusion of ATM-like functionality. The Examiner's Answer further asserts that Wasilewski already provides for the purchase of media at the kiosk, and cites, for example, paragraph [0060] where Wasilewski teaches "obtain an image from a remote location via the network connection 118, imaging camera 101, image scanner 106, or from a file stored on media such as a CD, memory card/stick, disk using the peripheral options available on the computer 112, so as to begin the image acquisition process 204."

While Wasilewski may function as an ATM, and provide for the purchase of media at the kiosk, this media is not blank. Applicants maintain that enabling the purchase of blank media from a Wasilewski device would impermissibly modify the principle of operation of Wasilewski because Wasilewski allows for the output of documents from the kiosk via

printers 110 and 120. Because Wasilewski functions as an ATM that outputs documents, Applicants maintain that it is unreasonable to combine Wasilewski with Roe in the manner suggested because of security risks.

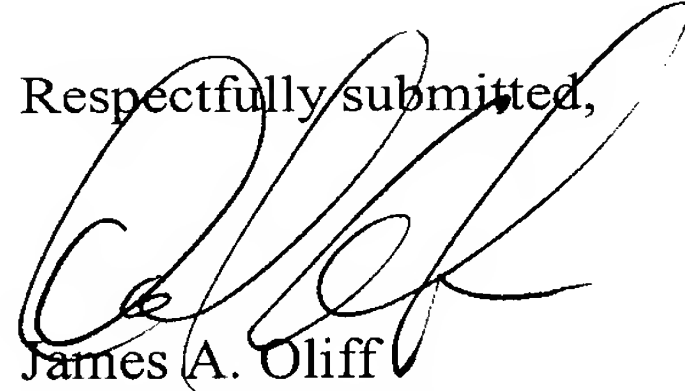
With respect to the Examiner's assertion that Wasilewski already provides for the purchase of media at the kiosk, Wasilewski teaches that the data for the image that is output is obtained from either a remote location, an imaging camera, an image scanner, or from a file stored on media such as a CD, memory card/stick, or a disk using the peripheral options available on the computer 112. Wasilewski then teaches that, at paragraph [0060], digital prints are generated at the large size image printer 120, and Photo ID or Photo Sticker selections are produced at the small size image printer 110. Lastly, Wasilewski teaches that other outputs at the kiosk include CD, memory card/stick and disk using the computer 112 peripherals. These outputs, are merely outputs of the media that is input into the peripheral options available on the computer 112 so that the image data for producing the digital prints can be obtained. Therefore, there is nothing in Wasilewski to suggest that Wasilewski outputs any other form of media besides the customized instruments (as indicated in the Abstract) at the kiosk.

For at least the foregoing reasons, Wasilewski and Roe are not combinable in the manner suggested by the Office Action.

III. Conclusion

For all the reasons stated in Appellants' Brief on Appeal, as well as the additional reasons set forth above, Appellants respectfully request that this Honorable Board reverse the rejections of claims 5, 6, 8-10, 12 and 15.

Respectfully submitted,



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